

CUSTOMER NO. 46900

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Attorney Docket No. A2550.0113/P113 A

In re application of: Martin Laurence Green and Lalita Manchanda

Serial No.: 10/718,536
Filed: 11/24/2003
Matter No.: 992.1208
Case Name: Green 32-18

Group Art Unit: 2813
Examiner: Schillinger, Laura M.
Phone No.: 571-272-1697

For: High K Dielectric Material and Method of Making a High K Dielectric Material

PETITION TO REMOVE FINALITY OF OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a petition to remove the finality of the second office action dated 08/08/06.

In the first office action dated 11/29/05, the Examiner rejected claims 13 and 17 under 35 U.S.C. § 102(e) as being anticipated by Yamazaki. Claim 17 depended directly from claim 13.

In response to the first office action, the Applicant filed the amendment dated 02/21/06, in which claim 13 was amended to incorporate the recitations of original claim 17. As such, amended claim 13 presented in that amendment was equivalent to original claim 17 rewritten in independent form.

In the second office action dated 08/08/06, the Examiner rejected amended claim 13 under 35 U.S.C. § 102(b) as being anticipated by Kato. As such, the second office action contained "a new ground of rejection" for the identical subject matter of original claim 17 that was "neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." See MPEP 706.07(a). The Applicant submits therefore that the finality of the second office action is premature and should be removed.

In response to the second office action, the Applicant filed the amendment dated 10/06/06. That amendment contained a similar argument that the finality of the second office action was improper and requested that the Examiner remove the finality of the second office action.

In the advisory action dated 11/08/06, the Examiner completely ignored the Applicant's argument about the impropriety of the finality of the second office action and simply refused to enter the amendment stating that "Applicant changed the scope of the claim requiring further search and consideration."

On 12/05/06, the Applicant's agent Yuri Gruzdkov had a telephone conversation with the Examiner, in which the finality issue was discussed. The Examiner's position with respect to the finality of the second office action expressed in that telephone conversation can be summarized as follows: (1) the Examiner admits that amended claim 13 presented in the amendment of 02/21/06 is equivalent to original

claim 17; (2) incorporation of claim 17 into claim 13 changed the scope of claims 14-16, 18-19, and 21, which depend variously from amended claim 13; (3) this change of scope required a new search; and (4) the new search warranted making the second office action final.

In response, the Applicant notes that, according to MPEP 706.07(a), the issue of finality turns on whether the new grounds of rejection were necessitated by Applicant's amendment of the claims, and not on whether a new search was required. It is therefore submitted that the Examiner applied an incorrect legal standard in the determination of whether the second office action could be made final. The Applicant further notes that, in the second office action, the Examiner did not maintain the initial grounds of rejection for the subject matter of original claim 17 presumably because the Applicant's arguments with respect to the allowability of that claim over Yamazaki clearly established that the initial rejection of original claim 17 over Yamazaki was improper. It is therefore clear that the **improperness of the rejection over Yamazaki**, and not the Applicant's amendment (as required by MPEP 706.07), **necessitated the new grounds of rejection** of the subject matter of original claim 17.

Accompanying this petition is a conditional RCE. If this petition is granted, then the Applicant submits that the amendment dated 10/06/06 should be entered and prosecution of the present application should be re-opened. If this petition is denied, then the Applicant requests entry of the conditional RCE to ensure that the present application does not go abandoned.

If the Commissioner determines that a fee is necessary for this petition, then authorization is hereby given to charge (or credit) **Deposit Account No. 50-0782** as required.

Respectfully submitted,

Date: 12/06/2006
Customer No. 46900
Mendelsohn & Associates, P.C.
1500 John F. Kennedy Blvd., Suite 405
Philadelphia, Pennsylvania 19102

/Yuri Gruzdkov/
Yuri Gruzdkov
Registration No. 50,762
Agent for Applicant
(215) 557-8544 (phone)
(215) 557-8477 (fax)